Supreme Court, U.S.
FILED
NOV 21 2003
OFFICE OF THE CLERK

No. 03-615

IN THE

Supreme Court of the United States

TODD MCFARLANE, ET AL.
Petitioners,

v.

ANTHONY R. "TONY" TWIST,
Respondent.

On Petition for Writ of Certiorari
To the Supreme Court of Missouri

RESPONDENT'S BRIEF IN OPPOSITION

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COUNTER-STATEMENT OF QUESTION PRESENTED

Is the use without permission of another person's name and identity in a published work, and collateral promotional material, protected by the First Amendment right of free speech when that use is for the purpose of marketing the work and the use of the name and identity is not a parody of or "of and concerning" the person whose name is appropriated?

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STATEMENT OF THE CASE

The Missouri Supreme Court correctly recognized that this case involves the manner in which the U.S. Constitution balances conflicting constitutionally recognized and protected interests – property rights *versus* speech rights – when one person pirates a celebrity's name and identity with the intent to obtain a commercial advantage and uses it as a ploy to sell its own work and related products. (A-14)[1] As it pointed out, its approach effected a true balance between the two, as opposed to the deceptive "balances" obtained through an inflexible application of the two tests that Petitioners propose. (A-18.) Its discussion of the weakness of the relatedness and transformative use tests, however, is not a rejection of those tests. Instead it is a recognition that those approaches are better applied under circumstances in which the use of another's identity is either wholly expressive or wholly commercial, a circumstance not before the court.

Thus, the approach applied by the Missouri Supreme Court does not conflict with the approaches adopted by the lower federal courts and state courts which have considered right of publicity cases but, rather, recognizes that different factual patterns may require different analytical methodologies. (See Point II, *infra*). More importantly, the true balancing approach adopted by the court follows the true balancing approach established by this Court in its precedent in which both constitutionally protected property interests and free speech interests are in competition. (See Point I, *infra*). Equally significant, the true balancing approach followed by the Missouri Supreme Court neither "chills

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[1] Citations to the opinion of the Missouri Supreme Court and Missouri Court of Appeals opinions below are to the case as found as an appendix to the Petition for Writ of Certiorari.

the First Amendment rights of speakers everywhere," (Petition for Writ of Certiorari at 2), nor forces individuals possessing a recognized property right in their name and identity to surrender that right to another wishing to pirate that identity for their own private commercial benefit. The Missouri Supreme Court does not require judgments to be made concerning the artistic value of the celebrity's name to the work but looks to the purpose behind the use of the celebrity's name. (See Point III, *supra*).

Tony Twist sued Petitioners for infringement of his right of publicity when Petitioners named a character in their *Spawn* comic book and HBO animated series after Tony Twist and used his name and professional identity as a hockey player in separate promotional publications. Petitioners sought to defend the claim on First Amendment grounds but, in doing so, never contended that their use of Tony Twist's name was a parody, (contrary to Petitioners' assertion). (Petition for Writ of Certiorari at 13, n.4). In addition, they got the defamation claim dismissed on the basis that the contents, character, story lines and description in *Spawn* is not identifiable with Tony Twist the hockey player and are not "of and concerning" him. (Mo. App. Opinion, App. A 28.)

At trial, the jury found that Petitioners had appropriated Tony Twist's name in violation of his right of publicity and awarded him actual damages of $24.5 million. (The size of the verdict is irrelevant to any issue before this Court since that part of the judgment ordering a new trial was affirmed.) The trial court granted Petitioners' post-trial motion, issuing a judgment notwithstanding the verdict ("JNOV") or, in the alternative, granting a new trial.

On appeal, the Missouri Supreme Court reversed the

trial court's JNOV and affirmed the grant of a new trial. In reversing the JNOV, the Missouri Supreme Court held that Tony Twist made a submissible case on his right of publicity claim and that the claim was not barred by the First Amendment. In ruling that a submissible case had been made, the court based its determination on evidence which showed that Petitioners intentionally used Tony Twist's name for one of the characters in *Spawn*; that Todd McFarlane the creator of *Spawn,* made certain that *Spawn* readers were informed in material collateral to the comic itself ("Spawning Ground" and *Wizard* magazine) that Tony Twist the hockey player was the namesake for Tony Twist the comic character; that McFarlane promised *Spawn* readers that they would continue to see characters in the comic named after current and past hockey players; that Petitioners marketed *Spawn* and its related products directly to hockey fans at hockey games; and that there were instances of *Spawn* and hockey fans making the connection between Tony Twist the hockey player and Tony Twist the comic book character. (A-11-13 and Resp. A. 1-3.)[2]

With respect to the First Amendment defense, the court concluded that the use of Tony Twist's name and identity was predominantly a ploy to sell Petitioners' products. (A-19.) While the casting of the Tony Twist character in *Spawn* comics as a mafia "enforcer" might be considered a "metaphorical reference" to Tony Twist the hockey player, the court noted that Petitioners themselves agreed that the Tony Twist character in *Spawn* was neither parody, expressive comment on or fictionalized account of Tony Twist the hockey player. (A-19.) Central to the Missouri Supreme Court's decision was the evidence that *Spawn* was not about Tony

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[2] "Resp. A.___" refers to Respondent's Appendix.

Twist the hockey player or hockey in general; and that neither the overall story line nor the story line relating to Tony Twist the comic character attempted to track the real Tony Twist's life. (A-10-11 & A-19.)

The facts relevant to the Missouri Supreme Court's decision on both the submissibility of the claim and the First Amendment issue are as follows:

Tony Twist, the person. Tony Twist was a hockey player with the St. Louis Blues and the Quebec Nordiques from 1988 until 1999. Twist was particularly popular with hockey fans and, as a result, endorsed products, appeared on radio and television shows, hosted his own television talk show (the "Tony Twist Show" on the St. Louis Fox affiliate) and became actively involved with several children's charities. Throughout his playing career, Twist received local and national notoriety in television, radio, and newspapers and was featured in numerous national and local magazines, including *Sports Illustrated*. His product endorsements included Met-RX, a sports nutrition supplement company, (Tr. 349)[3] as well as other nationally-marketed products. (Tr. 348-349.) In September of 1999, Twist was offered a contract to endorse the sports nutrition products of Experimental Applied Sciences ("EAS") at $100,000.00 per year, (Tr. 388), but EAS withdrew that offer after learning of the Tony Twist character in *Spawn*. His product endorsements, television and radio appearances, and his involvement with charities were intended to foster a positive image of himself and to further his career after hockey as a sports commentator and product endorser. (A-2.)

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[3] "Tr." refers to the official transcript of the record on appeal in the Missouri Supreme Court. Exhibits referenced are exhibits admitted into evidence at trial.

Tony Twist, the comic character. *Spawn*, a comic book created in 1992, centered on a CIA assassin named Al Simmons who had been killed by the mafia but returned to earth as the creature "Spawn" after making a deal with the devil. In 1993, a new character was added to the storyline, "Anthony 'Tony Twist' Twistelli," a character openly referred to as "Tony Twist" in the comic book, with McFarlane conceding in his testimony that the key name for the character was "Tony Twist". (Tr. 655). In addition to *Spawn*, the comic book, Petitioners and Time Warner Entertainment, Inc., through its HBO division, collaborated on the production of an animated series based on the *Spawn* story line. (Exhibit 26.) Tony Twist, the character, appeared in all six episodes of the animated series which was broadcast on HBO in the first season. In each of the six episodes, the character was referred to as "Tony Twist" and never as "Antonio Twistelli." McFarlane admitted the HBO series included important characters from the *Spawn* Comic Book (Tr. 776-779), and "Tony Twist" was one of the principal characters in the HBO animated series. (Exhibit 23.) The HBO *Spawn* was converted to video, DVD and laser disc format and was sold and rented to the public. (Exhibits 23, 24 and 25.)

Marketing Spawn using Tony Twist's name. Petitioner's internal documents established the Petitioners' marketing scheme for Spawn and its products would reach no less than 14.55 million people within a four to six month period. (Exhibit 39.) While Tony Twist the comic character was not "of and concerning" Tony Twist the hockey player, Petitioners created a direct relationship between the two in their marketing scheme. Tony Twist the comic character was specifically and intentionally named for Tony Twist the hockey player. Todd McFarlane, part owner of the Edmonton Oilers, is an avowed hockey fan. In "Spawning Ground," a section

of *Spawn* comics in which McFarlane responds to fan letters, McFarlane admitted on separate occasions that characters in *Spawn* were named for professional hockey players (such as Williams, Sakic, Twist, Linden and Roeniek),(Exhibit 16, Issue 20), that the character Tony Twist was named after Tony Twist the hockey player and further promised readers that they "will continue to see current and past hockey players' names in my books." (A-13; emphasis added). Two years later in the trade magazine *Wizard*, McFarlane again admitted that he uses the names of real-life people as the names of his characters and included a description of Tony Twist the hockey player among the most notable characters in *Spawn*. (Resp. A.1-3). Contrary to Petitioners attempts to portray Tony Twist as a minor character in their story line, (*see, e.g.,* Petition for Writ of Certiorari at 3), McFarlane testified that Tony Twist was an important character in both the *Spawn* comic and HBO series. (Tr. at 779.)

Other evidence showed that McFarlane was marketing *Spawn* directly to hockey fans. To promote the comic, McFarlane produced and licensed *Spawn* logo hockey pucks, hockey jerseys, toy zambonis, and other products, some featuring the character "Tony Twist." A *Spawn* night was sponsored at a minor league hockey game, at which McFarlane appeared and distributed *Spawn* products, including products containing the Tony Twist character. Another *Spawn* night was scheduled for an NHL venue but was never held. (A-5 and 13.)

Missouri's right of publicity cause of action. Notably missing from Petitioners' petition is any in-depth discussion of the right of publicity recognized by Missouri courts. The nature of the cause of action and its elements provide the factual framework by which the First Amendment issue must be viewed and also

determines the type of First Amendment analysis which must be applied to those facts.

Under Missouri law, the right of publicity is a recognized property right in a person's name or likeness that can be protected from infringement or appropriation by others. (A-14 and 16.) The essence of the right of publicity is the exclusive right and ability of a person to control the use of his name and unique identity for his economic benefit and the concomitant right to prevent others from pirating the name and identity for their own commercial benefit and unjust enrichment. (A-6-8.) Consistent with the right, the damages awarded for an invasion of the right of publicity focuses on the pecuniary loss to the plaintiff or the unjust pecuniary gain to the defendant. (A-7.) It does not seek to compensate the plaintiff for the personal injury to his or her reputation.

There are three elements to the cause of action under Missouri law: (1) the use of the plaintiff's name by the defendant as a symbol of the plaintiff's identity; (2) the use was without consent; and (3) the use was with the intent to obtain a commercial advantage through that use. (A-9.) As the Missouri Supreme Court explained with respect to this third element, "In a right of publicity case, plaintiff must prove that defendant intended to obtain a commercial advantage, and it is not enough to show that defendant incidentally obtained a commercial advantage by using plaintiff's name or that defendant had some other purpose in using plaintiff's name other than to obtain a commercial advantage." (A-9.) In short, for there to be an infringement of the right of publicity, the defendant must have intended to use the plaintiff's name in a commercial sense.

REASONS FOR DENYING THE WRIT

I.... THE MISSOURI SUPREME COURT'S OPINION IS CONSISTENT WITH THIS COURT'S APPLICATION OF THE FIRST AMENDMENT IN PRIOR DECISIONS.

It is helpful to first note precisely what Petitioners are urging here. Petitioners take exception to the balancing approach utilized by the Missouri Supreme Court. They do not challenge, however, the balance ultimately struck by the court in deciding the case. In addition, it matters not to the Petitioners whether the result they desire is arrived at through the relatedness or the transformative use test. They have no position on which of these tests should be applied.

Petitioners seek a determination that the First Amendment will protect a defendant's use of a celebrity's name as the name of a fictional character in a work unrelated to that celebrity and to promote the sale of the work by further use of the celebrity's name. Under such a ruling, a defendant could use the name or identity of a celebrity with impunity, creating characters in story lines that have nothing to do with the celebrity and then promoting the sale of the defendant's product to fans of the celebrity by merely slapping the celebrity names on characters throughout the work, and identifying the celebrity by name and professional identity in collateral publications. In addition to being inconsistent with the First Amendment principles explained below, such a ruling on its face would extinguish the cause of action for right of publicity.

As the Court recognized in *Lloyd Corporation, Ltd. v. Tanner*, 407 U.S. 551, 569 (1972), there are times when property rights will come into conflict with free speech rights. In such circumstances, the Court noted "that the

Fifth and Fourteenth Amendment rights of private property owners, as well as the First Amendment rights of all citizens, must be respected and protected. The Framers of the Constitution certainly did not think these fundamental rights of a free society are incompatible with each other." *Id.* Particularly *appropos* to this case is the Court's recognition that a simplistic enforcement of the free speech right at the expense of the private property right without some form of accommodation is effectively a dedication of private property for public use. 407 U.S. at 569.

In *Lloyd*, the Court made clear that when a conflict exists between the two constitutionally protected interests a balance must be struck which accommodates the protection of both. 407 U.S. at 567-68. Again particularly *appropos* to the issue in this case is the language used by the Court in rejecting the notion that property rights must be surrendered to free speech rights, language which presages the approach used by the Missouri Supreme Court in this case: "Such an accommodation [of the property interest strictly yielding to the free speech interest] would diminish property rights without significantly enhancing the asserted right of free speech." 407 U.S. at 567. In essence, what the Court requires is that consideration be given to how the purposes behind both constitutional interests are enhanced or diminished and an accommodation made between the two without one being unduly surrendered to the other.

The Court reiterated the need to balance the constitutionally protected interests in *Zacchini v. Scripps-Howard Broadcasting Company*, 433 U.S. 562 (1977). Significant for this case, the Court recognized that a celebrity's right of publicity is a state created property interest. 433 U.S. at 577. Again the Court made clear

that the property interest does not automatically surrender to the free speech interest when there is a conflict: "Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the First and Fourteenth Amendments do not immunize the media when they broadcast a performer's entire act without his consent." 433 U.S. at 574-75. In short, while the Court was presented with an easy fact situation for drawing the balance, it balanced the interests nonetheless.

Zacchini is also important for its discussion of the purposes behind the creation of the right of publicity. As the Court stated, "The rationale (for protecting the right of publicity) is the straightforward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay." 433 U.S. at 576 (internal quotations and citation omitted). In addition, protecting the right of publicity encourages individual effort by personal gain by providing an incentive to the celebrity to make the investment required to produce and continue his or her performance. 433 U.S. at 576-77, 97 S.Ct. at 2858. The Missouri Supreme Court likewise noted the importance of these purposes as part of the larger lessons that are to be considered in the balance of the constitutionally-protected interests. (A-15.)

Finally, the right of publicity promotes free speech from the standpoint of the celebrity's free speech interests. 433 U.S. at 578. The evidence in this case contains this same aspect. The right of Tony Twist to choose how his identity will be portrayed among the wide array of potential commercial and charitable ventures is itself a

form of expression. In protecting his identity and choosing what that identity will be used to promote, Tony Twist is publicly expressing who he is and what he stands for.

San Francisco Arts & Athletics, Inc. v. United States Olympic Committee, 483 U.S. 522 (1987) is the case most applicable to the instant one. Like the instant case, *San Francisco Arts & Athletics, Inc.* involved the property right of USOC to control the use of its name, specifically the word "Olympic." In determining that the protection of USOC's name was a significant governmental interest, the Court noted that the protection was justified "to ensure that the USOC receives the benefit of its own efforts so that the USOC will have an incentive to continue to produce a 'quality product' that, in turn, benefits the public." 483 U.S. at 537.

For the third time, the Court made clear that when there is a conflict between constitutionally protected property interests and constitutionally protected speech interests there must be a true balance of the interests. 483 U.S. at 536-37. One thing the Court considered in determining how the balance was to be achieved was that, like the right to publicity recognized under Missouri law, the legislation granting USOC a property interest in the word "Olympic" was directed at protection against appropriation of the word for commercial/promotional purposes, thus giving the limitation on speech embodied in the grant of the property right a commercial speech aura. 483 U.S. at 535. The Court looked to the predominant purpose behind the use of the word "Olympic" by San Francisco Arts & Atheltics, Inc., noting that it was clear that the organization sought to exploit the commercial magnetism of the word given value by USOC. 483 U.S. at 539.

Significantly, the Court recognized that the San

Francisco Arts & Athletics, Inc.'s use of the word "Olympic" in the promotion of its event was expressive in part, but then refused to conclude that the expressive use of the word automatically required the protection of that use under the First Amendment: "The mere fact that the SFAA claims an expressive, as opposed to a purely commercial, purpose does not give it a First Amendment right to 'appropriat[e] to itself the harvest of those who have sown.' The USOC's right to prohibit the use of the word 'Olympic' is at the core of its legitimate property right." 483 U.S. at 541.

Taken together, the Court's precedent in this area makes clear that the Missouri Supreme Court is true to the guidelines established by this Court. It applied a true balancing test that seeks to accommodate both the constitutionally protected property interests and the constitutionally protected speech interests that are involved. The Missouri Supreme Court's approach rejects the notion, also rejected by this Court, that the right of free speech is always exalted over property rights when the two come in conflict.

II. .... THERE IS NO CONFLICT BETWEEN THE DECISION OF THE MISSOURI SUPREME COURT BELOW AND OTHER COURTS.

Contrary to Petitioners' assertions, there is no conflict between the Missouri Supreme Court's opinion below and decisions of at least three Circuit Courts and the California and Kentucky courts. The Missouri Supreme Court did not condemn the transformative use test, relatedness test or malice test that Petitioners cite as other approaches used in this area. The Missouri Supreme Court did not outright reject these tests. It did hold that those tests were not useful to achieve the necessary constitutional balance between the competing constitutionally protected interests in what the

court described as "the unusual circumstances of the case at hand." (A-19). In other words, the Missouri Supreme Court recognized that application of the First Amendment in right of publicity cases is fact intensive.

Perhaps more importantly, the Missouri Supreme Court recognized that the transformative use test and relatedness test are merely means to an end. In contrast to those two tests, the court's approach focuses on the end – the fact that the competing constitutional interests are to be balanced. This becomes clear from the court's citation to Mark S. Lee, "Agents of Chaos: Judicial Confusion in Defining the Right of Publicity–Free Speech Interface," 23 LOY. L.A. ENT. L. REV. 471 (2003). (A-14.) As Lee points out, the transformative use and relatedness tests are useful "substantive analytic methodologies" that are available to achieve the ultimate balance that this Court requires:

> Such an approach [the approach applied by the Missouri Supreme Court below] would not be meaningful absent substantive analytic methodologies to help evaluate a particular use, but such methodologies are presently available, and have already been used by many courts. . . . The Restatement's "unrelatedness" test can also help evaluate whether use of an individual's identity in a work of expression is appropriate by helping to assess whether the use was intended to make a genuine comment about or merely to exploit the goodwill of the celebrity. Even the California Supreme Court's "transformativeness" test can help to determine whether the use is primarily exploitative or communicative by encouraging judicial focus on the nature of the use.

23 LOY. L.A. ENT. L. REV. at 500-501. In short, the transformative use test and the relatedness test are

devices for analyzing evidence that will have varying application depending on the fact pattern presented in a particular case.

With respect to this part of Petitioners' argument, it is also worth noting that, while Petitioners claim there is a conflict between Missouri Supreme Court's approach and the relatedness or transformative use tests, Petitioners have no opinion as to which of the methodologies should be applied. All they care is that the Missouri Supreme Court's opinion be reversed since its approach of balancing the competing constitutional interests involved was adverse to Petitioners. Before asking this Court to utilize its precious judicial resources, Petitioners should have, at least, articulated which alleged "conflicting" test they are championing.

The Transformative Use Test

The transformative use test was adopted in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001), *cert. denied* 534 U.S. 1078 (2002). The test was then subsequently applied in *Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003). The California court has described the transformative use test in the following words: "Another way of stating the inquiry is whether the celebrity likeness is one of the 'raw materials' from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question." 21 P.3d at 809.

Since the transformative use test and the approach applied by the Missouri Supreme Court are not in conflict, it should come as no surprise that there is language in *Comedy III* which parallels the language of the Missouri Supreme Court: "The inquiry is in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements pre

dominate in the work." *Id.* (emphasis added). Indeed, there is nothing in the description of the test developed by the California court which indicates that once even the smallest expressive element is discovered it is to be accorded First Amendment protection. The court's reference to such phrases as "so transformed," "become primarily," "predominate in the work," and "derive primarily," 21 P.3d at 809-10, does not describe a test which is so absolute in its application.

It is worth noting that the two cases in which the transformative use test has been applied share a common factual situation. Both involved challenges to visual depictions. *Comedy III* (lithographic reproductions of the Three Stooges printed on T-shirts); *Winter* (comic book illustration of worm-like creatures allegedly based on Johnny and Edgar Winter). The transformative use test serves well as an analytic methodology when a visual medium is at issue. A simple side-by-side comparison of the challenged work to the original will answer whether the challenged work is merely a literal depiction or imitation of a celebrity or whether it adds significant expressive content to the original. *See, especially, Winter*, 69 P.3d at 480 ("courts can often resolve the question as a matter of law simply by viewing the work in question and, if necessary, comparing it to an actual likeness of the person or persons portrayed"). Similar to *Zacchini*, the two visual medium cases in which the transformative use test has been applied are easy cases to resolve from a balancing standpoint. They involved facts which made it readily apparent how the constitutional balance should be drawn without any real need to analyze the factors that might tip the scales one way or the other. *Zacchini*, 433 U.S. at 574-75, 97 S.Ct. at 2857 ("Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that

the First and Fourteenth Amendments do not immunize the media when they broadcast a performer's entire act without his consent"); *Comedy III*, 21 P.3d 797 (obvious from reviewing the image printed on the T-shirts that they were no more than a literal depiction of the Three Stooges); *Winter*, 69 P.3d 473 (obvious from reviewing the illustration of the half-worm, half-human character in the comic that significant creative content was added and that the image was not a literal depiction or imitation of the Winters).

The Missouri Supreme Court was not dealing with visual images. There has been no contention by anyone that the comic character Tony Twist is meant to portray the real Tony Twist. Indeed, Petitioners go to great pains to drive this point home in their petition. (Petition for Writ of Certiorari at 3.) The Missouri Supreme Court was dealing with the very different factual situation of Todd McFarlane's admitted appropriation of the real Tony Twist's name for a character in *Spawn* and other clear identifications of Tony Twist the hockey player as the namesake of the comic's character in related promotional material. The Missouri Supreme Court's determination could not be resolved so easily as comparing the challenged work to a picture of the real Tony Twist. While the transformative use test might be a valid tool in the context of a case dealing with visual images, the Missouri Supreme Court's approach was neither a rejection of the transformative use test or in conflict with any decision purporting to apply it.

Relatedness Test

The Missouri Supreme Court would have been justified in not applying the relatedness test simply because the relatedness test has not typically been utilized as a test for applying First Amendment standards. Instead, the test defines the parameters of the right of publicity.

See, e.g., RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 46 & 47 (1995); *Rogers v. Grimaldi*, 875 F.2d 994, 1004-05 (2d Cir. 1989); *Montgomery v. Montgomery*, 60 S.W.3d 524, 528-29 (Ky. 2001). While these authorities often pay lip service to the First Amendment in their discussion of the underlying elements of the tort, *see, e.g.*, RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47, *comment* c (1995), the fact remains that this test does not purport to be a definitive standard for application of constitutional principles.

The Missouri Supreme Court would also be justified in not applying the relatedness test to the extent those tests are premised on *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). Petitioners admit such is the case and the fact is also borne out by the other two relatedness test cases cited by Petitioners. Both of them cite *Rogers* as the principal support for their decisions. *Montgomery v. Montgomery*, 60 S.W.3d 524, 528-29 (Ky. 2001); *Parks v. LaFace Records*, 329 F.3d 437, 461 (6th Cir. 2003). In its discussion of the relatedness test as it applied to the right of publicity, the *Roger's* court stated that is was defining the tort in accordance with state law free speech protections that were broader than those mandated by the federal constitution. 875 F.2d at 1004 (interpretation based on Oregon free speech clause "providing broader protection for free expression than that mandated by the federal Constitution"). *See, also, Id.* at 1005, n.13. The relatedness test fashioned by the *Rogers* court and adopted by the other courts on which Petitioners rely were clearly not fashioning a test based on federal First Amendment protections. Instead, they were fashioning a test that adopted a broader, more protective standard allowed by state law, but not mandated by federal law. Having eschewed such a broad definition of the right of publicity recognized by Missouri law, the Missouri Supreme Court's failure to

apply *Rogers* and its progeny cannot be said to create a conflict with the *Rogers* relatedness test.

Even absent these distinctions, the Missouri Supreme Court's decision is not in conflict with the cases cited by Petitioners. The relatedness test has utility as a substantive analytic methodology for particular fact patterns. It is worth noting that two of the cases deal with the names of celebrities in titles to expressive works. *Rogers, supra*; *Parks, supra*. It is clear from *Rogers* that is was creating a rule for titles: "In the context of allegedly misleading titles using a celebrity's name, that balance will normally not support application of the Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work." 875 F.2d at 999 (emphasis added). Petitioners go too far in attempting to describe this quoted excerpt as stating a rule for expressive works in general. (Petition for Writ of Certiorari at 15.) *Parks* similarly was concerned solely with whether the title of the song related to the underlying work. 329 F.3d at 461. From the standpoint of these two cases and their unique formulation of the relatedness test to titles, there is no conflict between the Missouri Supreme Court's opinion, which does not deal with the relationship of the title to the underlying work, and *Rogers* and *Parks*, which do.

The *Montgomery* case cited by Petitioners was not concerned with whether the use of an assumed celebrity's voice and image in a music video was protected by the First Amendment but with the definition of the right of publicity, the court saying in the ultimate, "We need not determine the correct definition of 'public figure,' because, as a matter of law, neither Harold's voice nor image was appropriated for 'commercial profit' within

the meaning of [the applicable] statute in the music video of John Michael's song 'I Miss You a Little.'" 60 S.W.3d at 528.

The process the Kentucky court used in deriving its statutory construction has significant implications for determining whether the Missouri Supreme Court's opinion on application of the First Amendment to the facts before it is inconsistent with the Kentucky court's definition of its statutory cause of action. The Kentucky statute begins with a simple proposition. If the medium in which the celebrity's name is used is of the type which would normally enjoy First Amendment protection, the use does not come within the statute and there is no right of publicity. 60 S.W.3d at 529 ("Therefore, we have little difficulty in concluding that the music video in question is protected free expression under the U.S. and Kentucky Constitutions. Thus, under the general rule, Barbara's right of publicity claim is not actionable"). However, "[l]ike all rules, an exception exists[.]" *Id.* That exception to the general rule applies if "the use is not sufficiently related to the underlying work, or, if the otherwise constitutionally-protected work is 'simply disguised commercial advertisement for the sale of goods or services.'" *Id.* In defining its cause of action, the Kentucky court narrows the broad general rule of non-inclusion for constitutionally protected mediums when the conditions of the relatedness test are satisfied. *Montgomery* does not purport to lay down a rule or even a methodology for analyzing the breadth or scope of the First Amendment in right of publicity cases.

Malice Standard

In *Zacchini*, the Court flatly rejected any contention Petitioners make that the malice standard of *New York Times v. Sullivan*, 376 U.S. 254 (1964) applies to right of publicity cases or that it is being applied by other

courts in such cases as *Zacchini*. 433 U.S. at 574 & 579. It reiterated that position in *Hustler Magazine v. Falwell*, 485 U.S. 46, 52 (1988). The other cases cited by Petitioners as malice standard cases do not stand for the proposition that the malice standard applies in right of publicity cases, *Hoffman v. Capital Cities*, 255 F.3d 1180 (9th Cir. 2001); *Flipside v. Chicago Tribune*, 564 N.E.2d 1244 (Ill. App. 1991) and *Food Lion v. Capital Cities*, 194 F.3d 505 (4th Cir. 1999), and it is impossible to see how they could do so consistent with *Zacchini* and *Falwell*.

III. ..... THE TEST APPLIED BY THE MISSOURI SUPREME COURT DOES NOT INVOLVE CONSIDERATION OF THE ARTISTIC VALUE OF THE CELEBRITY'S NAME TO THE WORK.

Petitioners misstate the essence of the decision below as permitting a judge to make a determination that "the artistic value of an isolated excerpt from the work is outweighed by its commercial value." (Petition for Writ of Certiorari at 21.) *See, also, Id.* at 7-8, 10, 20, 22. However, nowhere does the Missouri Supreme Court either state that such is the standard or engage in such an exercise in applying the standard to the facts of the case.

The Missouri Supreme Court's approach looks not to artistic merit but to the purpose in using the name and identity of the celebrity. Indeed, as the court's discussion of the weakness of the transformative and relatedness tests shows, the court was concerned that those tests were blind to the purpose of the author in using the celebrity's name in both a work and in related material designed to promote the work. (A-18.) With respect to the transformative use test, the court's criticism of that test was that "[u]nder the transformative test, the transformation or fictionalized characteriza

tion of a person's celebrity status is not actionable even if its sole purpose is the commercial use of that person's name and identity." (A-18; emphasis added.) In its discussion, the Missouri Supreme Court makes clear that it is concerned with the purpose in using another's name – if the work uses a celebrity's name predominantly for the purpose of exploiting the commercial value of that person's name, there should be both a violation of the right of publicity and a lack of First Amendment protection. *Id.* If on the other hand, the predominant purpose of the use of the celebrity's name is to make an expressive comment on or about that celebrity, the work is protected. *Id.*

In its application of the standard to the facts, the Missouri Supreme Court also made clear that it was concerned with purpose in use and not with the artistic contribution of that language. In finding that the purpose behind the use of Tony Twist's name was predominantly commercial, the court did not dwell on esoteric factors of literary or artistic style. It was concerned with the concrete evidentiary facts which showed Todd McFarlane's purpose for using the name in the first place – McFarlane's agreement that the use of Tony Twist's name was not for parody, other expressive comment or as a fictionalized account of Tony Twist; McFarlane's intentional identification of Tony Twist the famous hockey player as the source of Tony Twist the comic book character to the purchasers of his comic books; his promise to his readers that they would continue to see names of hockey players in future issues of *Spawn*; and his direct efforts to market his comic books to hockey fans at hockey games.

In stark contrast to this fact-intensive, purpose based inquiry is the subjective formulation of opinion on artistic contribution which the Petitioners propose be

made. Petitioners would have Missouri courts inquire as to whether allusions to "twist" endings and the use of "goon" and "enforcer" metaphors were artistic in nature and made an artistic contribution to the work. Pet. for Writ of Cert. at 16.

Finally, even if the Missouri Supreme Court's approach is as Petitioners mischaracterize it, the language of the cases applying either the transformative use test or relatedness test show that they themselves require the formulation of subjective opinions about the value or contribution of the celebrity's name in the work. *See, e.g., Comedy III*, 21 P.3d at 809-10 ("Another way of stating the inquiry is whether the celebrity likeness is one of the 'raw materials' from which an original work is synthesized")("asking whether the literal and imitative or creative elements predominate in the work")(transformative use test); *Rogers*, 875 F.2d at 999 ("unless the title has no artistic relevance to the work whatsoever, or, if it has some artistic relevance")(relatedness test). One cannot make judgments about the degree of synthesis of raw materials in a work, or about whether an element of the work is creative or imitative, or about whether an aspect of the work has artistic relevance without forming an opinion about the value or contribution of a celebrity's name in the material being considered. Neither of the alternatives proferred by Petitioners puts them or First Amendment analysis in any different or better position than application of what they argue is the flawed approach applied by the Missouri Supreme Court.

IV. ..... THE DECISION BELOW DOES NOT SATISFY THE "FINALITY" REQUIREMENTS OF 28 U.S.C. § 1257.

Petitioners affirmatively raise the question of the Court's jurisdiction under 28 U.S.C. § 1257, on the basis

of *Nike, Inc. v. Kasky*, 123 S.Ct. 2554 (2003)(*per curiam)*. As Petitioners concede, the Court's jurisdiction is limited to final judgments or decrees. 28 U.S.C. § 1257. Petitioners argue that this case comes within the fourth category of non-final judgments as identified in *Cox Broadcasting Corp. v. Cohn*, 420 U.S. 469 (1975). (Petition for Writ of Certiorari at 24.)

In *Cox*, the trial court had granted summary judgment to the plaintiff on the issue of liability, with the question of damages remaining to be tried. *Id.* at 474. As part of that summary judgment, the trial court rejected the defendant's constitutional challenge to the Georgia statute making it unlawful to publicize the name of rape victims in news reports. *Id.* On appeal, the Georgia Supreme Court reached the issue of the statute's constitutionality on rehearing, and determined that the statute passed constitutional muster. *Id.* at 475. Important to the Court's decision that it had jurisdiction under 28 U.S.C. § 1257 was its determination that "[t]he Georgia Supreme Court's judgment is plainly final on the federal issue and is not subject to further review in the state courts." *Id.* at 485 (emphasis added). As the Court realized, the constitutionality of the statute would not be a substantive issue that would be factually litigated in the subsequent proceedings. The two other cases on which the Court relied in *Cox* also possessed this same attribute: the federal issue was not going to be addressed anew in the continued proceedings. *Id.* at 483, *citing Construction Laborers v. Curry*, 371 U.S. 542 (1963), and *Mercantile National Bank v. Langdeau*, 371 U.S. 555 (1963). *See, also, Miami Herald Publishing Co. v. Tornillo*, 418 U.S. 241 (1974).

Petitioners ignore that in this case the Missouri Supreme Court was reviewing two separate actions of the trial court – the issuance of the JNOV and the

contingent grant of a new trial. The JNOV issue involved both the question of submissibility of the right of publicity claim and whether the First Amendment barred that claim under the facts as found at trial. (A-11-19.) In reviewing the submissibility issue, the Missouri Supreme Court considered the evidence in the light most favorable to the plaintiff , giving him all reasonable beneficial inferences. (A-10.) Having found that Tony Twist made a submissible case and that his claim was not barred under the particular facts as found at trial, the Missouri Supreme Court then turned to the contingent grant of a new trial and affirmed the trial court's action in that regard. (A-19-21.) Important for the "finality" issue under 28 U.S.C. § 1257, the reversal of the JNOV does not in any way preclude the litigation of Petitioners' affirmative defenses in the continued proceeding. The First Amendment federal issue that Petitioners ask this Court to review will be subject to further review in the new trial on the matter. Unlike *Cox*, *supra*, but like *Nike*, *supra*, the federal issue is subject to consideration *de novo* in the continued proceedings and to development of a set of facts applicable to the federal issue unique to those new proceedings. To paraphrase *Nike*, 123 S.Ct. at 2556 (Stevens, J, concurring), the resolution of the federal issue will be affected by the further proceedings because the federal issue must be analyzed in light of the facts developed during those proceedings. The case is not final under 28 U.S.C. § 1257.

CONCLUSION

Petitioners raise the specter of a number of dire consequences which will occur if the Court does not grant certiorari. The Petitioners argue that the exercise of protected speech will be chilled by the Missouri Supreme Court's opinion because that decision allows

judges to make subjective opinions about the literary value that a celebrity's name adds to a work. However, the Missouri Supreme Court does not require such an analysis. Petitioners predict that musicians, authors and movie producers will have to scrub their products of celebrity names when marketing their products in Missouri because of the restrictive view given First Amendment protections by the court below. However, the Missouri Supreme Court's opinion is not inconsistent with the transformative and relatedness tests applied to totally different factual patterns and, more importantly, it is consistent with this Court's precedent in the area. Stephen King does not have to fear Tom Gordon; Simon and Garfunkel do not have to fear Joe Dimaggio; Kim Carnes does not have to fear Bette Davis; and the makers of the film "Searching for Bobby Fischer" do not have to fear Bobby Fischer, in Missouri. Finally, Petitioners foresee that celebrities will flock to Missouri courts to press their right of publicity claims, again because of what Petitioners characterize as a less First Amendment-friendly attitude here than elsewhere. However, Missouri is not more tolerant of the right of publicity in light of First Amendment protections than any other jurisdiction considering the issue. There is no reason to believe that Missouri will become a safe haven for celebrities wanting to protect their names and identities from appropriation by others. When stripped of all of its hyperbole, Petitioners' *in terrorem* argument states no cause for review by the Court.

The petition for writ of certiorari should be denied.

Respectfully submitted,

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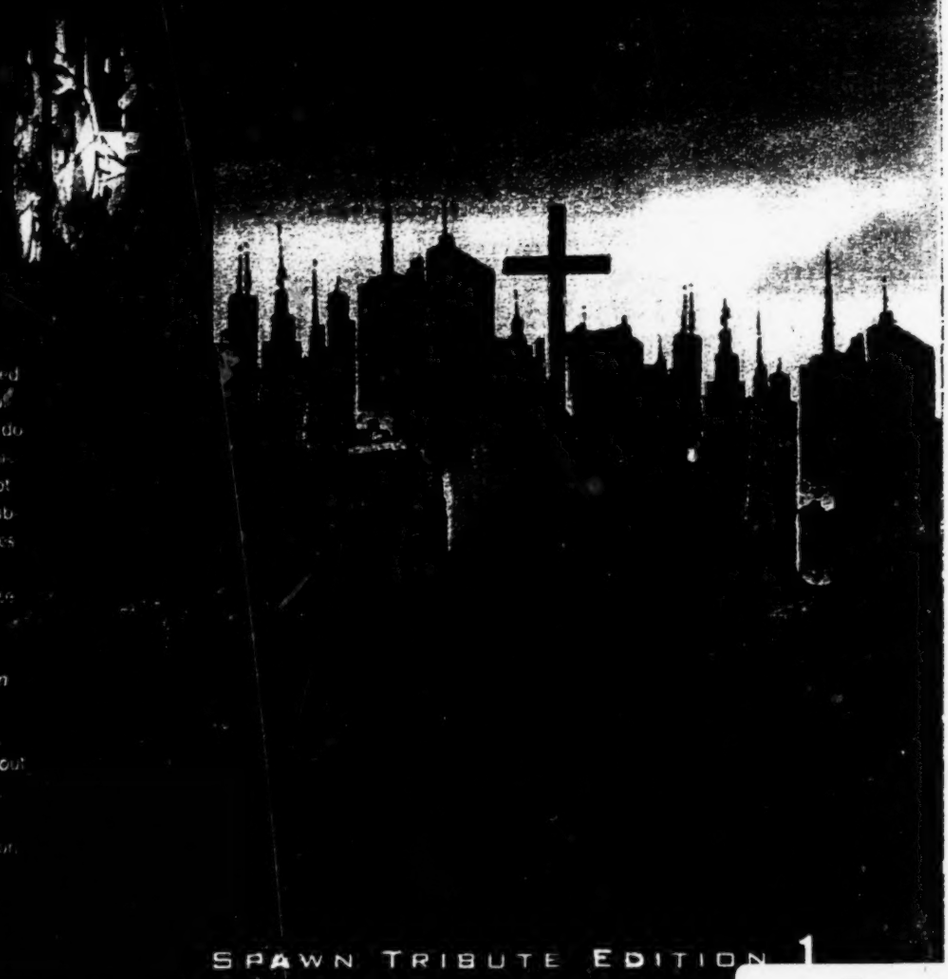
WIZARD SPAWN TRIBUTE



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Cover Artist: Tony Daniel
Cover Colors: Twilight Graphics

Wizard Spawn Tribute is an original special edition published by Wizard Press.

Wizard Press
151 Wells Avenue
Congers, NY 10920
(914) 268-3594
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SPAWN TRIBUTE EDITION 1

SPAWNING GROUND

BY SCOTT BEATTY

A look at the real-life people Spawn characters are based upon

Having trouble coming up with character names? Use the Todd McFarlane Method.

McFarlane uses the names of his family and friends when it comes to the character identities inside his comic book *Spawn*.

"It's easier to come up with the names of people sitting next to you," the writer/artist explains. "And for the most part, if I don't put my friends and family in my books, I guarantee that nobody at Marvel is going to do it for me. I do it just because I can. I've got that freedom. It's one of the great things about controlling your own book."

Named for loved ones, friends, colleagues and employees at Todd McFarlane Productions, a few of the characters appearing in *Spawn* feature similarities to their real-life counterparts. Many others appropriate only the name, sometimes being introduced and dispatched in the same issue. The following is a collection of the most notable players, as well as some interesting cameos:

AL SIMMONS/SPAWN

First Appearance: *Spawn* #1
Real-Life Persona: Al Simmons
Relation: Todd McFarlane's old roomie

The real Al Simmons played PAC 10 baseball and roomed with McFarlane while the pair attended college at Eastern Washington University. After his namesake gained fame in the pages of *Spawn*, Al quit his day job and went to work full time for Todd McFarlane Productions. As McFarlane recalls, Simmons approached him and said, "I'd like to go around the country dressed as Al Simmons...and be Spawn." Who could portray Spawn better than the real Al Simmons? Now a regular feature on the comic convention circuit, Simmons attends 15 to 20 shows a year dressed in Spawn's trademarked togs, signing autographs and appearing with the souped-up Spawnmobile dragster. Between public appearances, Simmons takes the costume off and spends his time as head of productions and marketing for TMP.

WANDA BLAKE

First Appearance: *Spawn* #1 (First Named: *Spawn* #3)
Real-Life Persona: Wanda Kolomyjec
Relation: McFarlane's wife

Todd McFarlane's junior-high sweetheart Wanda Kolomyjec became his wife in 1985 and helped launch *Spawn* as the title's first editor. Together for 18 years now, McFarlane reveals that the caring, charitable nature of Wanda Blake is very much apparent in his own significant other and soulmate. "He loves his Wanda and I love my Wanda," says McFarlane of Spawn. "Wanda is really the sole reason for Spawn's existence. He didn't make the deal with the Malebolgia for revenge. He came back because he wanted to see his wife. The similarity is drawn to my wife. I'd trade anything to save my wife's life or to prolong being together."

Resp. A.2

TERRY FITZGERALD

First Appearance: *Spawn* #3
Real-Life Persona: Terry Fitzgerald
Relation: TMP's Director of Creative Development

"The real Terry is some little white guy who could stand to lose a few pounds, so he's not as svelte and good-looking as the fake Terry Fitzgerald," McFarlane jokes. Spawn's former best friend in the comic takes his appellation from the person McFarlane considers his "right-hand man" at TMP. Director of Creative Development Terry Fitzgerald has been with McFarlane since his days on Marvel's *Spider-Man*. From a humble beginning doing comics' grunt work with McFarlane in Vancouver, British Columbia, Fitzgerald has risen the ladder of success, becoming an invaluable asset to TMP and handling much of the major licensing for Spawn. "If I don't have the answer, Terry does. And in many cases," McFarlane admits, "Terry has more answers."

CYAN FITZGERALD

First Appearance: *Spawn* #3 (First Named: *Spawn* #6)
Real-Life Persona: Cyan McFarlane
Relation: McFarlane's daughter

The uniquely named daughter of Terry Fitzgerald and Wanda Blake is the comic book counterpart of Cyan McFarlane, the daughter of Todd McFarlane and Wanda Kolomyjec. And as McFarlane reveals, despite some people's difficulty in pronouncing "Cyan" (si-an), the name has special meaning. "It's a primary color of blue in printing," he says. "Given that my dad has been in the printing business his entire career, and that's what I was going to go into if I didn't break into comics, we thought it was a cool name. That people have trouble even saying the word is really perplexing to me."

DETECTIVE SAM BURKE

First Appearance: *Spawn* #1
Real-Life Persona: Paul Burke
Relation: President of McFarlane Toys

McFarlane admits that the Oliver Hardy of police detectives is a hybrid in terms of naming, borrowing the surname only. Paul Burke, whose last name McFarlane used for the jelly doughnut-noshing detective, is actually the president of McFarlane Toys. "They don't have any similarities other than liking to do a little bit of smoking," reveals McFarlane.

"TWITCH" WILLIAMS

First Appearance: *Spawn* #1
Real-Life Persona: Pam Williams
Relation: Wanda Kolomyjec's best friend

As with Sam Burke, "Twitch" Williams takes only his last name from a real person, although the first name of Burke's sharpshooting partner has yet to be divulged. The surname comes from Pam Williams, a friend of Wanda Kolomyjec. McFarlane is quick to point out that Pam Williams' entire name appears in *Spawn* #42, where her more-apparent counterpart is the young girl with the crush on comic book collector Pat Shaunessy. (Shaunessy just happens to be named for the owner of Golden Age Collectibles, McFarlane's old comic shop haunt in Vancouver.)

ANTHONY "TONY TWIST" TWISTELLI

First Appearance: *Spawn* #6
Real-Life Persona: Tony Twist
Relation: NHL St. Louis Blues right winger

The Motley Crue that has made life exceedingly rough for Al Simmons and his loved ones, in addition to putting out an ill-advised contract on Tim Vickers, is named for former Quebec Nordiques hockey player Tony Twist, now a renowned enforcer (i.e., "goon") for the St. Louis Blues of the National Hockey League.